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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,361	01/14/2005	Guido Bieker	01013.0162.PCUS00	2310

32894 7590 11/15/2006

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2941 FAIRVIEW PARK DR., SUITE 200  
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EXAMINER

STORMER, RUSSELL D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/521,361

Applicant(s)

BIEKER ET AL.

Examiner

Russell D. Stormer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21, 23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 and 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12, 13, 18-21, 23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/10/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Election***

1. Applicant's election with traverse of the third species in the reply filed on September 21, 2006 is acknowledged. The traversal is on the ground(s) that it would not be an undue burden on the Examiner to search and examine all eight embodiments of the invention.

This is not found persuasive because Applicant has offered no proof that the search and examination of all eight species of the invention would not be serious burden on the Examiner. Nor has applicant shown that all eight embodiments and their limitations would be searched in the same search as alleged. Therefore, Applicant's traversal of the election requirement amounts to nothing more than an opinion as it is not based on any facts.

Applicant's statement that PCT Rule 13.1 is not applicable is not understood. The present applicant was filed under Rule 371 and must be restricted under the PCT rules. Further, the fact that a European Patent Office Examiner did not restrict the corresponding PCT application has no bearing on the present application which is being examined in the United States.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 7-11 and 14-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The “pair of wheels,” the “wheelset,” and the axle” as set forth in claims 1, 23, and 25 are not shown in the drawings. The “elliptical or oval bore” of claim 13 is not shown. The device mounted “adjacent both wheels” as set forth in claim 18 is not shown. The axle and the “drive engaging the axle” as set forth in claims 19 and 20 are not shown. The control system of claim 21 is not shown.

Therefore, these features must be shown or else be canceled from the claims.

**No new matter should be entered.**

4. The drawings are objected to because the dotted line profile in the body of the tread of the wheel in figures 1-4 is not identified. The solid line in the rim flange of the tread in figures 7-9 is not identified. It is not clear what either of these lines are intended to represent.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

The "friction determining surface" of claims 1, 23, and 25 is not described in the specification.

The "elliptical or oval bore" of claim 13 is not described.

There is no description of the drive engaging the axle or the midpoint of the axle as set forth in claims 19 and 20.

There is no description of the control system of claim 21.

See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4, 19, 23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Ackerman.

Ackerman discloses a rail wheel having a mass 13 resiliently mounted thereto using a spring plate 14 and a spring means 15. A friction determining surface 16 is disposed between the mass and the wheel.

With respect to claim 23, the method of reducing the vibrations is inherent as taught by the structure of Ackerman.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5, 18, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ackerman.

Ackerman meets all of the limitations of claims 1, 4, and 19 as set forth above and is further applied in that to use a centering sleeve around the bolt 19 to mount the mass to the disc would have been obvious as such center sleeves are well-known to those of ordinary skill and would help better locate the mass on the wheel.

With respect to claim 18 it would have been obvious to use a vibration absorbing device on both wheels of a wheelset for obvious reasons.

With respect to claim 20, the point at which the drive engages the axle is obvious as a mechanical expedient.

With respect to claim 21, control systems for vehicles are well-known, and to apply one to the vehicle on which the wheel of Ackerman is mounted would have been obvious in order to control slip, etc.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ackerman in view of Seimiya.

To employ a spring sleeve in a bore with a counter bore would have been obvious as taught by Seimiya in order to mount the segment or Ackerman in a resilient manner on the wheel.

11. Claims 1-4, 6, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otto in view of Seimiya.

Otto discloses a rail wheel comprising a brake disc attached to the wheel through a plurality of bolts. The brake disc contacts the wheel at a friction surface. The brake is not mounted to absorb vibration.

Seimiya teaches a vibration isolation device a wheel mounted to a hub. A bore and a counter bore in the wheel receive a sleeve and a spring element to mount the wheel to the hub. From this teaching it would have been obvious to mount the brake discs of Otto et al to the wheel using vibration isolating sleeves and spring members in order to reduce vibrations of the brakes as this would reduce the noise generated by the

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wheel and brake assembly. With respect to claim 13, to use an oval or elliptical bore would have been obvious in order to allow for thermal expansion of the brake disc.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show other wheel and brake assemblies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (571) 272-6687. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

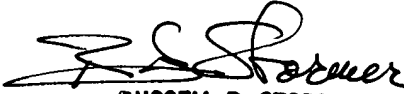
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/13/06

  
RUSSELL D. STORMER  
PRIMARY EXAMINER 11/13/06